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**OFFICE OF PETITIONS**

Docket No.: A3156.0022/PO22

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#8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Mitsuhiro Ono

Application No.: 09/873,649

Confirmation No.: 4262

Filed: June 4, 2001

Art Unit: 2133

For: Integrated circuit for modem

Examiner: J. D. Torres

**REQUEST FOR RECONSIDERATION OF  
DECISION ON PETITION TO WITHDRAW  
HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181**

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AUG 17 2004

Technology Center 2100

U.S. Patent and Trademark Office  
220 20th Street S.  
Customer Window  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Dear Sir:

Reconsideration of the Decision on Petition to Withdraw Holding of Abandonment under 37 C.F.R. § 1.181, mailed July 7, 2004 is respectfully requested.

The Decision on Petition raises two matters. First, the Decision states that the Office properly mailed papers to Ostrolenk, Faber, Gerb & Soffen, LLP, 1180 Avenue of the Americas, New York, New York 10036-8403, Customer No. 2352 ("Ostrolenk"). Petitioner does not disagree. Note that while the original Petition stated that a change of address was prepared in 2002, it did not represent that the address change was filed. However, the Office is advised that a change of address was duly filed on May 28, 2004. A

copy of that change of address together with the return receipt postcard evidencing receipt by the PTO is attached hereto.

Secondly, the Decision on Petition states that the proof of non-receipt of an Office Action of September 23, 2003 is inadequate even though that Action mailed was returned to the Office and has been found in the file wrapper, thus establishing that it never actually reached the Ostrolenk firm. One basis for this determination is that the Decision on Petition presumes that an entity known as "Morgan Stanley Mail Services" was an agent of the Ostrolenk firm, even though such a presumption is inconsistent with the label endorsed by Morgan Stanley Mail Services which indicates that Morgan Stanley Mail Services had no record of the addressee.

To rebut the presumption, the Declaration submitted herewith establishes that the Ostrolenk firm never employed the services of Morgan Stanley Mail Services for any purpose and Morgan Stanley Mail Services has no physical presence in the building where Ostrolenk maintains its offices.

The attached Declaration also provides those portions of the showing which the Decision noted were missing. In particular, the Declaration provides a statement from the practitioner [Ostrolenk] stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the relevant docket records does not indicate that the Office communication was received; and a copy of the docket record referenced in the practitioner's statement where the non-received Office communication would have been entered had it been received and docketed. A statement by the practitioner having custody of the file jacket (the undersigned) attesting to the fact that a search of the file jacket indicates that the Office communication was not received is a part of the original Petition. The undersigned previously provided a statement stating that the Office communication was not received by him and attesting to the fact that a search of the

relevant docket records does not indicate that the Office communication was received; and submitted a copy of the docket record referenced in his statement where the non-received Office communication would have been entered had it been received and docketed.

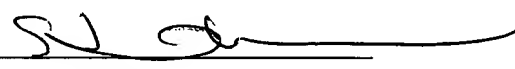
In light of this Declaration, it is respectfully submitted that the record establishes that the Office Action of September 23, 2003 was delivered by the U.S. Postal Service to a third party (Morgan Stanley Mail Services) which neither had any association with the Ostrolenk firm nor a physical presence in the building in which Ostrolenk had offices, and that the third party returned the Office Action directly to the Patent Office rather than to Ostrolenk. The record establishes that the Office Action was never received by the addressee (Ostrolenk), actually or constructively.

The attention of the Office is also directed to the fact that a petition fee was submitted with the original Petition. Since the Decision on Petition indicates no fee was required, a refund of that fee is respectfully requested.

Granting of the Petition to Withdraw Holding of Abandonment and the re-issuance of the Office Action of September 23, 2003 is respectfully requested.

Dated: July 30, 2004

Respectfully submitted,

By   
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**Inventor:** Mitsuhiro Ono

**Atty Docket No.:** A3156.0022/PO22

**Application No.:** 09/873,649-Conf. #4262

**Filing Date:** June 4, 2001

**Title:** Integrated circuit for modem

**Documents Filed:**  
Change of Correspondence Address

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**Via:** PTO - Daily Run

**Sender's Initials:** SIW/mgs

**Date:** May 28, 2004

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